

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CISCO SYSTEMS, INC.  
Petitioner

v.

CAPELLA PHOTONICS, INC.  
Patent Owner

---

Case IPR2014-01166  
Patent RE42,368

---

**PATENT OWNER PRELIMINARY RESPONSE**

***Mail Stop “PATENT BOARD”***  
Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

## Table of Contents

I.	INTRODUCTION .....	1
II.	BACKGROUND .....	4
	A. Overview of the Technology.....	5
	B. Summary of '368 Patent.....	7
	C. Summary of the Petition.....	8
	1. Summary of Bouevitch .....	9
	2. Summary of Smith Patent and the '683 Provisional.....	12
III.	CLAIM CONSTRUCTION .....	16
IV.	the Petition does not establish a prima facie case that the independent claims of the '368 patent are obvious and contains irreparable and substantial evidentiary gaps.....	20
	A. Petitioner failed to make a threshold showing that the Smith patent is entitled to the § 102(e) prior art filing date of the '683 provisional .....	22
	B. Petitioner failed to determine the scope of the prior art and independently ascertain the differences between the claimed invention and the prior art .....	27
	C. Petitioner failed to show why a POSA would have been motivated to combine Bouevitch and Smith .....	29
	D. Bouevitch teaches away from Smith.....	32
	E. Bouevitch does not teach or suggest “an input port,” “one or more other/drop/add ports,” and “an output port,” as recited by independent claims 1, 15 and 16 .....	37
	F. The Smith patent does not teach “beam deflecting elements . . . continuously controllable in two dimensions” as recited in independent claims 1, 15, 16 and 17 .....	42

1. The Smith patent does not teach or suggest “each of said elements being individually and continuously controllable” in two dimensions as recited in independent claims 1, 15, 16, and 17 .....44

G. The Smith patent is substantially similar to references from original prosecution and the two reissues, so institution should be denied for all grounds using the Smith patent.....46

V. The grounds are redundant and the petitioner fails to provide “meaningful distinctions” between the grounds.....48

VI. CONCLUSION.....50

**Table of Authorities**Cases

<i>Application of Lund</i> , 376 F.2d 982 (C.C.P.A. 1967).....	23
<i>Application of Warner</i> , 379 F.2d 1011 (C.C.P.A. 1967).....	21
<i>Biotec Biologische Naturverpackungen GmbH &amp; Co. KG v. Biocorp, Inc.</i> , 249 F.3d 1341 (Fed. Cir. 2001) .....	17
<i>CallCopy, Inc. v. Verint Americas, Inc.</i> , IPR2013-00486, Paper 11 (P.T.A.B. Feb. 5, 2013) .....	22
<i>CCS Fitness, Inc. v. Brunswick Corp.</i> , 288 F.3d 1359 (Fed. Cir. 2002) .....	16
<i>Crocs Inc. v. International Trade Commission</i> , 598 F.3d 1294 (Fed. Cir. 2010) .....	30
<i>DeSilva v. DiLeonardi</i> , 181 F.3d 865 (7th Cir. 1999) .....	19, 29
<i>Ex Parte Mortensen</i> , No. 2010-012383 (B.P.A.I. May 7, 2012).....	21
<i>Google Inc. v. EveryMD.com LLC</i> , IPR2014-00347, Paper 9 (P.T.A.B. May 22, 2014) .....	19, 29
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	27
<i>In re Chaganti</i> , 2014 WL 274514 (Fed. Cir. 2014) .....	21
<i>In re Giacomini</i> , 612 F.3d 1389 (Fed. Cir. 2010) .....	22
<i>In re Gurley</i> , 27 F.3d 551 (Fed. Cir. 1994) .....	33

<i>In re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006) .....	21
<i>In re Morris</i> , 127 F.3d 1048 (Fed. Cir. 1997) .....	16
<i>K-2 Corp. v. Salomon S.A.</i> , 191 F.3d 1356 (Fed. Cir. 1999) .....	18
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	21, 27, 29, 30
<i>Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.</i> , CBM2012-00003, Paper 7 (P.T.A.B. Oct. 25, 2012) .....	48, 49
<i>Medrad, Inc. v. MRI Devices Corp.</i> , 401 F.3d 1313 (Fed. Cir. 2005) .....	18
<i>Mentor H/S, Inc. v. Med. Device Alliance, Inc.</i> , 244 F.3d 1365 (Fed. Cir. 2001) .....	17
<i>Olympus Am., Inc. v. Perfect Surgical Techniques, Inc.</i> , IPR2014-00233, Paper 16 (P.T.A.B. June 16, 2014) .....	49
<i>Pac-Tec, Inc. v. Amerace Corp.</i> , 903 F.2d 796 (Fed. Cir. 1990) .....	18
<i>Perry v. Amerace Corp.</i> , 502 U.S. 808 (1991).....	18
<i>Synopsys, Inc. v. Mentor Graphics Corporation</i> , IPR2012-00041, Paper 16 (P.T.A.B. Feb. 22, 2013) .....	17
<i>United States v. Adams</i> , 383 U.S. 39 (1966).....	29
<i>Zodiac Pool Systems, Inc. v. Aqua Products, Inc.</i> , IPR2013-00159, Paper 18 (P.T.A.B Aug. 23, 2013).....	32
<u>Statutes</u>	
35 U.S.C. § 102(e) .....	passim
35 U.S.C. § 103(a) .....	20

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.